

REMARKS

Claims 1-5, 7 and 8, as amended, remain herein. Claims 9 and 10 are added but are of the same scope as former claims 4 and 5.

Applicants note and appreciate the statement in the Office Action, page 6, that claims 6 and 8 would be allowable if rewritten in independent form. Independent claim 1 has been amended to include the limitation of former claim 6, and claim 8 has been amended to include all of the limitations of former claim 1, thereby placing the subject matter of each of former claims 6 and 8 in allowable, independent form. Claims 2-5 and 7 are dependent upon amended claim 1. Thus all claims 1-5, 7 and 8 are now fully in condition for allowance, which is respectfully requested.

1. Claims 4 and 5 were rejected under 35 U.S.C. § 112, paragraph two, the Office Action requesting clarity with respect to a metal club head having a ceramic strike face. Claim 4 has been amended to recite “the golf club head according to claim 1, additionally comprising a ceramic strike face,” thereby clarifying that the ceramic strike face is an additional element of a metal club head. Claim 5 has been amended for clarity to make it consistent with claim 4, upon which it depends. In view of the amendments to claims 4 and 5, the rejection under § 112, paragraph two should be moot, and reconsideration and withdrawal thereof are respectfully requested.

2. Since all claims 2-5, 7 and 8 are now dependent upon an allowable independent claim which includes the limitations of former claims 6 and 8, which were stated in the Office Action to be allowable, the § 103(a) rejections of any of claims 1-5, 7 and 8 are now moot, and withdrawal thereof is respectfully requested.

3. Claims 4 and 5 were rejected under § 103(a) over Kobayashi '971 in view of Chang '636, further in view of Inamori '023.

As indicated above, new claims 9 and 10 are of the same scope as former claims 4 and 5. It is also noted that the language of claims 9 and 10 has been clarified with respect to a metal club head additionally comprising a ceramic strike face, as discussed above with respect to claims 4 and 5.

The Office Action admits that neither Kobayashi nor Chang discloses a strike face made of ceramic. However, the Office Action alleges that Inamori discloses a club head having a ceramic strike face, citing the abstract of Inamori '023.

However, Inamori does not disclose a golf club head having a ceramic strike face wherein the strike face has surface roughness of less than 0.25  $\mu\text{m}$ , and a Vickers hardness of greater than 5 GPa, as expressly recited in applicants' claim 9. Thus, there is no disclosure or teaching in Inamori which would have suggested applicants' presently claimed invention to one of ordinary skill in the art.

The Office Action admits that Kobayashi also does not disclose surface roughness or hardness. And, Chang is limited to a metal golf club having a metal strike face having certain surface roughness and hardness for the express purpose of reducing ball spin—the exact opposite of the effect of applicants' claimed invention. And, Chang does not disclose a golf club head having a ceramic strike face. Thus, there is no disclosure or teaching in either Kobayashi or Chang that would have suggested applicants' presently claimed invention. Further, there is no disclosure or teaching in Inamori which would suggest that a ceramic strike face for a golf club can or should be made to have the surface roughness and hardness specified in applicants' claims. The Office Action simply assumes those things in view of hindsight knowledge of applicants' disclosure, without demonstrating any basis in the prior art itself for such assumptions.

Thus, there is no disclosure or teaching of applicants' claimed invention in any of Kobayashi, Chang or Inamori, and there is no disclosure or teaching in any of those references that would have suggested the desirability of combining any portions thereof effectively to anticipate or suggest applicants' presently claimed invention. Accordingly, reconsideration and withdrawal of this rejection (as it might relate to new claims 9 and 10) and allowance of claims 9 and 10, are respectfully requested.

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For all the foregoing reasons, all claims 1-5, and 7-10 are now proper in form and patentably distinguished over all grounds of rejection cited in the Office Action. Accordingly, allowance of all claims 1-5 and 7-10 is respectfully requested.

The PTO is authorized to charge/credit any necessary fees or overpayment to applicants' attorneys' deposit account No. 19-4293. Should the Examiner feel that further amendment would place this application into even better condition for issue, the Examiner is invited to telephone applicants' undersigned attorney at the number listed below.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Roger W. Parkhurst", is written over a horizontal line.

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